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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,998	02/27/2002	Benjamin R. Yerxa	03678.0102.CPUS00	3186

27194 7590 03/30/2005

HOWREY SIMON ARNOLD & WHITE, LLP
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EXAMINER

OWENS JR, HOWARD V

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,998

Applicant(s)

YERXA ET AL.

Examiner

Howard V. Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Response to Restriction Requirement

Claims 4 and 10 – 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 3, 2003.

Claim 4 is withdrawn because it is drawn to the variables Y and Z as being “OH”; wherein the elected species is drawn to Y and Z consisting of the acetal or ketal according to Formula III.

Claims 10 - 20 are withdrawn as being drawn to unrelated inventions, having different modes of operation and function, wherein each method is patentably distinct from the other based on the claimed effect.

An action on the merits of claims 1-3 and 5-9 are set forth in the action below.

Claim Objections

Claim 2 appears to be missing a period, appropriate correction is required.

Specification

Reference to Continuing Applications

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The present status of all parent applications should be included in any amendment/response to this action.

Minor informalities

The disclosure is objected to because of the following informalities: Page 4 , line 8, appears to contain the misspelled term "allergan". Appropriate correction is required for this and any other spelling or grammatical errors not noted herein.

DOUBLE PATENTING

Use only when the filing date of the of the examined application is later than the conflicting application and the claims of the conflicting application fit within (species of) the scope of the examined application.

Claims 1-3 and 5-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Application no. 09/643,138 ('138). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claims(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claims(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of '138 is generic to the instant claims 1-3 and 5-9 when alkyl moieties are claimed, specifically OR₁. That is claims 1-3 and 5-9 fall entirely within the scope of claim 1 of '138 when the variable OR₁ is alkyl. Instant claims 1-3 and 5-9 are drawn to a nucleotide compound of Formula 1, wherein the "A" moiety is defined as OR₁, wherein R₁ represents alkyl.

Claim 1 of '138 anticipates the claim to alkyl substituents as it is drawn to a nucleotide compound of Formula 1 wherein the "A" moiety is defined as alkyl.

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Howard V. Owens
Patent Examiner
Art Unit 1623

A handwritten signature in black ink, appearing to read 'James O. Wilson', written over a horizontal line.

James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (571) 272-0658 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (571) 272 - 0661.